

1 REMARKS

2 Status of the Claims

3 Claims 1-23 remain pending in the application. Claims 1, 8, 11, 12, 13, 18, 20, 21, and 22 are
4 amended to more particularly point out and claim the subject matter thereof.

5 Preliminary Remarks

6 Support for the amendments to claims 1, 8, 13, 18, and 22 is provided at least by applicants'
7 specification at page 9, lines 7-21. Support for the amendments to claims 11 and 20 is provided at
8 least by original claim 1. No new matter has been added.

9 Claims Rejected Under 35 U.S.C. § 112

10 The Examiner rejected claims 1-23 35 USC 112, first paragraph, is failing to comply with the
11 written description requirement. Applicants respectfully traverse the Examiner's rejections and
12 request reconsideration for at least the following reasons.

13 In particular, the Examiner rejects claims 1 and 22 for addition of the word
14 "*simultaneously*" (Emphasis added), by amendment, and which the Examiner now asserts is new
15 matter. The Examiner also rejects claim 1 for addition of the phrase "*user is able to visually*
16 *compare*" (Emphasis added), which was also added by amendment, and which the Examiner is
17 also now asserting is new matter not supported by any disclosure in the application as filed.
18 Applicants respectfully direct the Examiner's attention to applicants' specification at page 8,
19 lines 10-12, which reads:

20 In one embodiment, live preview *allows the user to view and compare* a selected
21 portion of text, referred to as the live preview text 205, in several formats *at the same*
22 *time*. Thus, the user is able to visualize the appearance of the live preview text 205 in
23 different formats, before actually selecting a format for reformatting the text in the
24 document 114. (Emphasis added.)

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1 Applicants respectfully submit that the phrase "*at the same time*" is equivalent to the word
2 "*simultaneously*" both as a term of art and in plain meaning. Therefore, the applicants assert that no
3 new matter has been added to claims 1 and 22 by addition of the term "simultaneously." Similarly,
4 applicants respectfully submit that the phrase "*the user is able to visually compare*" is equivalent to
5 the cited portion of the specification, which reads, "*allows the user to view and compare.*"
6 Therefore, the applicants further assert that no new matter has been added to claim 1 by addition of
7 the phrase "*the user is able to visually compare.*"

8 The Examiner also rejected claim 13 for addition of the phrase "*without applying any of the*
9 *formats to the portion of text*" (Emphasis added), which the Examiner is asserts is new matter.
10 Applicants respectfully direct the Examiner's attention to page 3, lines 16-20 of applicants'
11 specification, which reads "the user may view and compare the portion of text formatted in a variety
12 of formats from the format set and/or custom formats, *prior to actually reformatting a portion of text*
13 *in the document.*" (Emphasis added.) Applicants respectfully submit that the phrase "*without*
14 *applying any of the formats to the portion of text*" is equivalent to or clearly implied by the phrase
15 "*prior to actually reformatting a portion of text in the document.*" Therefore, applicants assert that
16 no new matter has been added to claim 13 by addition of the phrase "*without applying any of the*
17 *formats to the portion of text.*"

18 In light of the above remarks, the applicants respectfully submit that the rejection of
19 claims 1, 13, and 22 under 35 USC section 112 first paragraph, as including new matter is improper
20 and should be withdrawn. Furthermore, since claims 2 -12 depend from claim 1, claims 14-21
21 depend from claim 13, and claim 23 depends from claim 22, applicants submit that rejection of each
22 of those claims for this reason is also improper and should also be withdrawn.

23 Claims Rejected Under 35 U.S.C. § 103(a)

24 The Examiner has rejected claims 1-23 as being unpatentable over Russo Borland ("Running
25 Microsoft Word 97," published by Microsoft Press, Redmond, Washington 1997, hereinafter referred to
26 as "Borland") in view of Parker et al. U.S. Patent No. RE 36, 704, filed 11/16/1995, issued 5/16/2000
27 (hereinafter "Parker"). The Examiner further asserts that Parker cures the deficiencies of Borland.
28 Applicants respectfully disagree that the cited art, either alone or read together, renders applicants'
29 claims obvious, for at least the following reasons.

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1 In the interest of reducing the complexity of the issues for the Examiner to consider in this
2 response, the following discussion focuses on independent claims 1, 13, and 22 (as amended). The
3 patentability of each remaining dependent claim is not necessarily separately addressed in detail.
4 However, applicants' decision not to discuss the differences between the cited art and each dependent
5 claim should not be considered as an admission that applicants concur with the Examiner's conclusion
6 that these dependent claims are not patentable over the disclosure in the cited references. Similarly,
7 applicants' decision not to discuss differences between the prior art and every claim element, or every
8 comment made by the Examiner, should not be considered as an admission that applicants concur with
9 the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all
10 of the dependent claims are patentable over the cited references. Moreover, a specific traverse of the
11 rejection of each dependent claim is not required, since dependent claims are patentable for at least the
12 same reasons as the independent claims from which the dependent claims ultimately depend.

13 As a preliminary matter, applicants would like to respectfully submit that the particular
14 reformatting functionality disclosed by applicants' specification and as recited in the claims is non-
15 trivial, and any differences in operation, however slight in comparison to the disclosure and teaching of
16 the references, still represent significant and distinguishable differences between the reference and
17 applicants' claim recitation, due to the nature of the art. Furthermore, it should be noted that Borland is
18 actually directed to teaching features of software that applicants' improve upon with the approach
19 recited in the claims and which is commonly owned by the same entity as applicants' invention.
20 Finally, applicant has amended the claims to more particularly point out and claim the subject matter
21 recited therein, in light of the cited art. Therefore, the Examiner is requested to carefully consider the
22 following arguments that show why these claims are patentable over the art cited.

23 With regard to independent claim 1 (as amended), applicants' recited claim language is
24 neither taught nor suggested by Borland. Furthermore, applicants assert that Parker does not cure
25 the deficiencies of Borland. Specifically, the Examiner claims that Borland "discloses
26 identifying the portion of text to be reformatted by text located adjacent to the cursor (claim 11)"
27 (Official Action, Para. 23). In fact, as the Examiner notes, Borland only discloses "to simply
28 have Word apply a format to your document quickly after you're done adding text, set an
29 insertion point in the document (or select a portion of the document if you want to decorate only
30 that portion)" (Official Action, Para. 23). However, Borland never specifically teaches or

1 suggests *"simultaneously displaying live preview text reformatted in each of the formats in the*
2 *sample of formats in a live preview window"* where the live preview text is *"constrained to the*
3 *portion of document text disposed immediately adjacent to a cursor position in a document"*
4 (Emphasis Added) as recited by applicants' amended claim 1. In fact, Borland is silent as to whether
5 any text is even selected by "setting an insertion point" let alone whether the selected text is
6 *"constrained to the portion of document text disposed immediately adjacent to a cursor position in a*
7 *document"* (Emphasis Added). Furthermore, Borland shows in Figures 2-4 on page 38 that
8 formatting changes are applied to the entire document, rather than to "live preview text in a live
9 preview window," and clearly, Borland does not show formatting changes applied to preview text
10 that is "constrained to the portion of document text disposed immediately adjacent to a cursor position
11 in a document" as recited in applicants' amended claim 1. Also, as the Examiner noted, Borland
12 discloses that a portion of document text can be *selected* if a user desires to decorate only that portion
13 of text. However, no user input is required in applicants' claims, to constrain "live preview text" "to
14 the portion of document text disposed immediately adjacent to a cursor position in a document," and
15 therefore, Borland again fails to disclose or suggest each element of applicants' amended claim 1.

16 Furthermore, while Parker discloses the simultaneous display of "sample text" in different
17 formats, Parker does not disclose or teach that the "sample text" is from an actual document. Instead,
18 Parker appears to use the same "sample words" for all format examples. Parker is silent as to the
19 selection of text from within a document, and therefore Parker never actually discloses or even
20 suggests "live preview text" taken from an actual document, or that the preview text is *"constrained*
21 *to the portion of document text disposed immediately adjacent to a cursor position in a document,"* as
22 required by applicants' amended claim 1.

23 Therefore, since neither Borland nor Parker actually teaches or suggests each and every
24 element of applicants' amended claim 1, the cited references cannot be combined to reach applicants'
25 recitation in claim 1 (as amended). The Examiner has rejected independent claims 13 and 22 for
26 the same reasons as claim 1. However, as amended, claims 13 and 22 similarly recite details (as
27 discussed above) that are neither taught nor suggested by the applied references. Accordingly,
28 applicants respectfully request reconsideration of the claims and withdrawal of the rejection of
29 independent claims 1, 13, and 22 under 35 U.S.C. § 103.

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1 Because dependent claims are considered to include all of the elements of the independent
2 claims from which the dependent claims ultimately depend and because neither Borland nor Parker
3 disclose or suggest all of the elements of independent claims 1, 13, and 22, the rejection of dependent
4 claims 2-7, claim 8 (as amended), claims 9-10, claims 11-13 (as amended), claims 14-17, claim 18
5 (as amended), claim 19, claims 20-21 (as amended), and claim 23, under 35 U.S.C. § 103 over
6 Borland should also be withdrawn for at least these reasons.

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8 Respectfully submitted,

9 

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12 RMA/PJN

13 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
14 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,
15 Alexandria, VA 22313-1450, on September 22, 2005.

16 Date: September 22, 2005

